

¶ 2.10.01 Continuation or Divisional Application Contains New Matter Relative to the Prior-Filed Application

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to change the relationship (continuation or divisional application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: **[1]**.

Examiner Note

1. This form paragraph should be used when an application claims the benefit of a prior-filed application under **35 U.S.C. 120, 121, or 365(c)**, contains new matter, and purports to be a "continuation," "division," or "divisional application" of the prior-filed application. Do not use this form paragraph if the applicant is claiming the benefit of a provisional application under **35 U.S.C. 119(e)**.

2. In bracket 1, provide an example of the matter not disclosed in the prior-filed application.

II. TIME FOR FILING LATER-FILED APPLICATIONS

A. Claiming the Benefit of Provisional Applications

When a later-filed application is claiming the benefit of a prior-filed provisional application under **35 U.S.C. 119(e)**, the nonprovisional application must be filed not later than 12 months after the date on which the provisional application was filed. If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application may be filed on the next succeeding business day. See **35 U.S.C. 21(b)**, **37 CFR 1.7(b)**, and **MPEP § 201.04(b)** and **§ 505**.

Public Law 106-113 amended **35 U.S.C. 119(e)(2)** to eliminate the copendency requirement for a nonprovisional application claiming benefit of a provisional application. **35 U.S.C. 119(e)(2)** as amended by Public Law 106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999. Although a nonprovisional application claiming the benefit of a provisional application is not required to be copending with the provisional application, abandonment of a provisional application for failure to pay the basic filing fee would indicate that the nonprovisional application could not claim the benefit of the provisional application because the basic filing fee was not paid within the time period set forth in **37 CFR 1.53(g)** as required by **37 CFR 1.78(a)(4)**.

Applicant may claim the benefit of a provisional application by claiming the benefit of an intermediate copending nonprovisional application. The later-filed application must claim the benefit of the intermediate nonprovisional application under **35 U.S.C. 120, 121, or 365(c)**; the intermediate application must be filed not later than 12 months after the filing date of the provisional application; and both the later-filed

application and the intermediate application must claim the benefit of the provisional application under 35 U.S.C. **119(e)**.

B. Claiming the Benefit of Nonprovisional Applications - Copendency

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. **120**, **121**, or **365(c)**, the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application. Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. Thus, the later-filed application may be filed under 37 CFR **1.53(b)** while the prior application is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. Patents usually will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed.